

I. Status of the Claims

Claims 18, 20-28, and 30-51 are pending in this application.

II. Rejections Under 35 U.S.C. § 103

Claims 18, 20-28, and 30-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 99/13830 to Mitsumatsu et al. ("Mitsumatsu") in view of WO 98/03155 to Sebag et al. ("Sebag"). Office Action dated April 21, 2004 ("Office Action") at pages 2-5. Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness the Examiner has the burden to show, among other requirements, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in that art, to modify the reference or to combine the reference teachings. M.P.E.P. § 2143. Applicants submit that the Examiner has failed to do so here.

In response to the arguments made in the Response dated February 4, 2004, the Examiner "maintains the position that applicants' provided no evidence that the substitution of the Mitsumatsu optical brightener with the Sebag pearlescent agents is somehow insufficient." Office Action at page 4. However, the "examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. § 2142 at 2100-128. The Examiner attempts to legitimize the previous position by arguing that the "earlier remarks regarding the absence of evidentiary support for the applicants' arguments refers to the fact there is no convincing arguments or

evidence to rebut the objective teachings that a hair cleansing composition comprising the Sebag pearlescent agent would impart such cosmetic benefits.”

Office Action at page 5.

Applicants respectfully submit that the Examiner, however, has not sufficiently cited objective teachings to make such a prima facie case of obviousness. Applicants reiterate that the factual inquiry to combine references must be thorough and searching, and must be based on objective evidence in the record. In the present case, the Examiner has not presented sufficient objective evidence to support her subjective, unsupported assertion of obviousness. Specifically, the Examiner has pointed to no objective evidence that would have led one skilled in the art to substitute an optical brightener, which has one function for an opacifier, which has a different function. Thus, the burden remains with the Examiner and Applicants are not required to come forward with any evidence of nonobviousness.

In response to our argument that the Examiner’s burden is particularly difficult in this case because optical brighteners and opacifiers/pearlescent agents have different functions and, therefore, the Examiner has not shown a motivation to substitute one for the other, the Examiner notes “that it is clearly taught in Sebag that the invention imparts shiny hair as well.” Office Action at page 5. The Sebag reference does not indicate, nor does the Examiner even allege, that it is the dialkyl ether of Sebag that imparts the shiny property to the hair as opposed to the numerous ingredients of the Sebag composition. Applicants reiterate that opacifiers

and pearlescent agents, such as the dialkyl ether of Sebag, are used in order to give opacity or pearlescence to the composition, not the hair.

In response to our argument that there is no reasonable expectation in making the suggested substitution because of the importance of triazole to the Mitsumatsu invention, the Examiner, citing *In re Keller*, notes that “the test for obviousness is not whether the feature of the secondary reference may be bodily incorporated into the structure of the primary reference . . . [r]ather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” Office Action at page 5.

Applicants’ argument, however, is not whether or not the substitution may actually be made, i.e., in the Examiner’s language, whether or not the dialkyl ether of Sebag may be bodily incorporated into the composition of Mitsumatsu by substituting it for the triazole. Indeed, it can be, as is shown by our invention. Rather, Applicants’ argument is that one skilled in the art would not have been motivated to make the substitution based on the combined teachings of the art, which the Examiner acknowledges is a test for determining obviousness. Office Action at page 5.

The Examiner, at page 4 of the Office Action, further argues that the motivation to use the Sebag pearlescent agent in the hair shampoo formulation of Mitsumatsu is “objectively and notoriously” found in the reference where it indicates that the use of at least one fatty dialkyl ether in the composition renders a washing foaming composition having insoluble silicones and surfactants, pearlescent effect, good homogeneity, and improved stability while maintaining foaming power.

Applicants are unclear which reference the Examiner refers to and where such a teaching is “objective and notoriously” found. Applicants submit that this is not a proper motivation as the Mitsumatsu invention is concerned with enhancing the shininess of the hair and protecting the hair from further damage. See Mitsumatsu at page 1, lines 8-11, 28-30. The Examiner does not explain why one skilled in the art would choose to enhance the pearlescent effect of Mitsumatsu. With regards to the properties of stability, foaming power, and homogeneity, the Examiner fails to articulate why one skilled in the art would have been motivated to choose the Sebag dialkyl ether from the multitude of cosmetic agents available that could to enhance these properties.

For at least the above reasons and the reasons of record, Applicants respectfully submit that Mitsumatsu in view of Sebag does not establish a prima facie case of obviousness. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

III. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims. If the Examiner believes a telephone call could be useful in resolving any outstanding issues, the Examiner is invited to contact Applicants' undersigned counsel at 202-408-4388.

Please grant any extensions of time required to enter this response and
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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